

**REMARKS/ARGUMENTS**

This Amendment is in response to a final Office Action mailed May 10, 2005, in which (1) claims 37-39 were objected to for informalities, (2) claims 1, 3 and 7 were rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter, (3) claims 37-39 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention, and (4) claims 22-39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 6,149,055 to Gatto (“**Gatto**”).

By the present Amendment, Applicant proposes canceling claims 23 and 39 and incorporating the subject matter thereof in their respective parent claims 22 and 37. If entered, claims 22 and 24-38 would stand pending. It is respectfully requested that this Amendment be entered since the effect would be merely the cancellation of claims, and would also put the application in condition for allowance. Alternatively, if the Examiner does not believe the claims would be in condition for allowance, it is requested that this Amendment be entered for purposes of putting the claims in better form for purposes of appeal.

**§101 Rejection**

As to rejection of claims 1, 3 and 7 under 35 U.S.C. §101, Applicant points out that those claims were previously cancelled and are no longer pending. It is assumed that this rejection was made in error, but if the Examiner believes certain claims do not meet the requirements of 35 U.S.C. §101, it is respectfully requested that the finality of the Office Action be removed so Applicant may effectively respond to the rejection.

**§112 Rejection**

As to the rejection of claims 37-39 under 35 U.S.C. §112, Applicant points out that claim 37 (as amended) and claim 38 (by incorporating the steps of its parent claim 37) now recite several clear method steps, such as the steps beginning with the phrases "storing in a

database...", "issuing a negotiable instrument...", "maintaining a sweep account..." and "upon any such deposit, immediately debiting the sweep account..".

As to the Examiner's comment that "lines 11-16 appear to be directed towards providing a server where a negotiable (not prepaid) instrument is issued", Applicant points out that it is clear from the context of the various claim steps that the providing of a server (now in lines 12-17 of claim 37) does in fact carry out the intended method of issuing a "prepaid" negotiable instrument (see for example, the reference at line 5 to "funds deposited to the account as advance payment for negotiable instruments").

It is believed that claims 37 and 38 do meet the requirements of 35 U.S.C. §112, but if not , it is again respectfully requested the Examiner withdraw the finality of the Office Action and provide clarification on this rejection, so that Applicant may directly address any specific concerns that the Examiner may have.

### **§103 Rejection**

As to the rejection of the claims under 35 U.S.C. §103 (as unpatentable over **Gatto**), Applicant believes that, with the cancellation of claims 23 and 39, such rejection has been clearly overcome. As mentioned in the earlier response of October 18, 2004, **Gatto** is not concerned with, nor does it show or suggest, a system like Applicant's invention where a prepaid account is maintained for the purpose of permitting withdrawals in the form of negotiable instruments. While **Gatto** does mention that an EFT system may conduct a variety of transactions, including issuing negotiable instruments (col. 5, line 41), the ATM system in **Gatto** discloses no means for issuing negotiable instruments. In addition, the system in **Gatto** is not one for maintaining an account "wherein the balance represents funds deposited to the account as advance payment for negotiable instruments, and wherein withdrawals against the account are made only by issuance of negotiable instruments", as recited in independent claim 22. Even more clearly (as a result of the amendments to claims herein), **Gatto** does not disclose a system where the "prepaid account is maintained by a non-banking institution and the prepaid account is thus not an FDIC insured account", and does not disclose a communications link for receiving

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"data relating to a sweep account" at a banking institution for receiving deposits, and for  
"immediately crediting those deposits to the prepaid account", as is now recited in claim 22.

### **Conclusion**

In view of the foregoing, Applicant believes all claims now pending in this application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



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